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PATENT
Customer No. 22,852
Attorney Docket No. 09812.0178-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Takehiko NAKANO) Group Art Unit: 2621
)
Application No.: 10/062,991) Examiner: Chowdhury, Nigar
)
Filed: February 1, 2002)
)
For: CONTENT) Confirmation No.: 2851
)
RECORDING/REPRODUCING)
APPARATUS AND METHOD,)
STORAGE MEDIUM AND)
COMPUTER PROGRAM)

Mail Stop Appeal Brief--Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL OF APPEAL BRIEF (37 C.F.R. 41.37)

Transmitted herewith is the APPEAL BRIEF in this application with respect to the
Notice of Appeal filed on February 14, 2007.

This application is on behalf of

☐ Small Entity ☒ Large Entity

Pursuant to 37 C.F.R. 41.20(b)(2), the fee for filing the Appeal Brief is:

☐ \$250.00 (Small Entity)

☒ \$500.00 (Large Entity)

TOTAL FEE DUE:

Appeal Brief Fee \$500.00



Extension Fee (if any) \$ 0.00

Total Fee Due \$500.00

☒ Enclosed is a check for \$500 to cover the above fees.

PETITION FOR EXTENSION. If any extension of time is necessary for the filing of this Appeal Brief, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to Deposit Account 06-0916. A duplicate copy of this paper is enclosed for use in charging the deposit account.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 4, 2007

By: 

Michael R. Kelly
Reg. No. 33,921



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Attention: Mail Stop Appeal Brief - Patents

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Sir:

APPEAL BRIEF UNDER BOARD RULE § 41.37

In support of the Notice of Appeal filed February 14, 2007, and further to 37 C.F.R. 41.37(a)(1), Appellant presents this brief and encloses herewith a check for the fee of \$500 required under 37 C.F.R. 41.20(b)(2).

This Appeal responds to the final rejection of claims 1-26 mailed October 19, 2006 and to the Advisory Action mailed January 12, 2007.

If any additional fees are required or if the enclosed payment is insufficient, Appellant requests that the required fees be charged to Deposit Account No. 06-0916.

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TABLE OF CONTENTS

I. Real Party in Interest	3
II. Related Appeals and Interferences	4
III. Status of Claims	5
IV. Status of Amendments	6
V. Summary of Claimed Subject Matter.....	7
VI. Grounds of Rejection	10
VII. Argument.....	11
VIII. Claims Appendix to Appeal Brief Under Rule 41.37(c)(1)(viii).....	16
IX. Evidence Appendix to Appeal Brief Under Rule 41.37(c)(1)(ix).....	24
X. Related Proceedings Appendix to Appeal Brief Under Rule 41.37(c)(1)(x).....	25

Customer No. 22,852
Application No.: 10/062,991
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I. Real Party in Interest

The real party in interest is Sony Corporation, the assignee of record.

II. Related Appeals and Interferences

There are currently no other appeals or interferences, of which Appellant, Appellant's legal representative, or the assignee are aware, that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

In the Final Office Action mailed October 19, 2006, the Examiner rejected claims 1-26 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,010,801 to Jerding et al. ("*Jerding*").

The final rejection of claims 1-26 is being appealed and a list of the claims on appeal is found in the attached Claims Appendix.

Each claim of this patent application is separately patentable, and upon issuance of a patent will be entitled to a separate presumption of validity under 35 U.S.C. § 282. However, for the limited purpose of this appeal of the Examiner's rejection under 35 U.S.C. §102(e), Appellant groups all of the claims together.

IV. Status of Amendments

All amendments have been entered. No amendments subsequent to the final rejection have been filed.

V. Summary of Claimed Subject Matter

The present invention provides a content recording/reproducing apparatus, a storage medium, and a computer program which are capable of recording and reproducing content which is limited in its recording retention period or reproduction period.

Independent claim 1 is directed to a content recording/reproducing apparatus for controlling the recording and reproducing of content limited in a viewable period. *See*, for example, specification at page 19, lines 7-10 and Fig 1. The apparatus includes a content recording means for recording content received from the outside. *See*, for example, specification at page 20, lines 17-23 and Fig. 1, ref. 13. The apparatus includes a determination means for determining a viewable period of the recorded content. *See*, for example, specification at page 23, line 20 - page 24, line 13 and Fig. 1, ref. 11. The apparatus also includes a presentation means for presenting information associated with said viewable period of said recorded content. *See*, for example, specification at page 25, lines 7-20 and Fig. 1, ref. 15. The apparatus also includes a content reproduction means for reproducing said recorded content. *See*, for example, specification at page 22, lines 7-18 and Fig. 1, ref. 13. The apparatus further includes a reproduction control means for controlling a reproducing operation of said content reproduction means in accordance with said viewable period of said recorded content. *See*, for example, specification at page 23, line 20 - page 24, line 18 and Fig. 1, ref. 16.

Independent claim 13 is directed to a content recording/reproducing method for controlling the recording and reproduction of content limited in a viewable period. *See*, for example, specification at page 10, line 18 - page 11, line 5. The method comprises

recording content received from the outside. *See*, for example, specification at page 20, lines 17-23. The method also comprises determining a viewable period of the recorded content. *See*, for example, specification at page 23, line 20 - page 24, line 13. The method also comprises presenting information associated with said viewable period of said recorded content. *See*, for example, specification at page 25, lines 7-20. The method further comprises reproducing said recorded content in accordance with a relationship between a recording retention period of said recorded content and a current time. *See*, for example, specification at page 23, line 20 - page 24, line 18.

Independent claim 25 is directed to a storage medium physically storing computer software in a computer-readable format, said computer software being written so as to execute, on a computer system, control of recording and reproducing operations of content limited in a viewable period. *See*, for example, specification at page 14, line 18 - page 15, line 8. The computer software comprises the step of recording content received from the outside. *See*, for example, specification at page 20, lines 17-23. The computer software comprises the step of determining a viewable period of the recorded content. *See*, for example, specification at page 23, line 20 - page 24, line 13. The computer software also comprises the step of presenting information associated with said viewable period of said recorded content. *See*, for example, specification at page 25, lines 7-20. The computer software further comprises the step of reproducing said recorded content in accordance with a relationship between a recording retention period of said recorded content and a current time. *See*, for example, specification at page 23, line 20 - page 24, line 18.

Independent claim 26 is directed to a computer readable medium storing a computer program written so as to execute, on a computer system, control of recording and reproducing operations of content limited in a viewable period. *See*, for example, specification at page 16, line 20 - page 17, line 6. The computer program comprises the step of recording content received from the outside. *See*, for example, specification at page 20, lines 17-23. The computer program comprises the step of determining a viewable period of the recorded content. *See*, for example, specification at page 23, line 20 - page 24, line 13. The computer program also comprises the step of presenting information associated with said viewable period of said recorded content. *See*, for example, specification at page 25, lines 7-20. The computer program further comprises the step of reproducing said recorded content in accordance with a relationship between a recording retention period of said recorded content and a current time. *See*, for example, specification at page 23, line 20 - page 24, line 18.

VI. Grounds of Rejection

A. Claims 1-26 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,010,801 to Jerding et al. ("*Jerding*").

VII. Argument

**A. The Board Should Reverse the Rejection Under § 102(e)
Because All Elements of the Claims Are Not Taught By *Jerding***

The Examiner's rejection of claims 1-26 under 35 U.S.C. §102(e) as being anticipated by *Jerding* should be reversed.

To properly anticipate Appellant's claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See MPEP § 2121, *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." MPEP § 2131. In this application, the Examiner has not demonstrated that each and every element of the claims are taught by *Jerding* .

Claim 1 recites a content recording/reproducing apparatus including, for example:

content recording means for recording content received from the outside;

determination means for determining a viewable period of the recorded content;

presentation means for presenting information associated with said viewable period of said recorded content;

content reproduction means for reproducing said recorded content;
and

reproduction control means for controlling a reproducing operation of said content reproduction means in accordance with said viewable period of said recorded content.

(emphasis added). *Jerding* does not disclose each and every element of Appellant's claimed invention.

Jerding discloses a "method for an interactive media services system to provide media to a user through an interactive media services client device" (col. 2, lines 26-28). A MOD (media-on-demand) current rental screen 270 informs a user that a MOD title has been previously rented and that its rental duration has not expired (col. 25, lines 16-20). "The lower portion of the display 271 displays the MOD title currently rented, the length of the MOD title, and the rental time remaining" (col. 25, lines 20-22).

In *Jerding*, the user may rent and view a MOD title for a predetermined duration of time. The user may fast-forward, rewind, play, pause, and stop the video. There is no teaching, in *Jerding*, that the user may record the video. The Examiner cites col. 4, lines 1-18 to teach a content recording means (Final Office Action at page 4). Appellant respectfully disagrees. This passage discloses components for a cable television system 10. Subscriber equipment may include cable-ready television sets, video recorders, or computers (col. 4, lines 16-17). This is a generic list of equipment that a user may operate. The video recorder, however, does not record the MOD title.

The Examiner states, "[i]n order to receive MOD (media-on-demand) service, the program should be recorded somewhere" (Final Office Action at page 2). The MOD title may be stored at a server, but the title is not recorded at the user end. The title is only rented and viewed, not recorded. The user may only view a video during a rental period (col. 18, line 58 - col. 19, line 23). Once the user selects the title to view, the information is transmitted across the network and presented to the user for viewing only during a rental period. No recording occurs.

The Examiner also states, “Jerding discloses that [the] program is recorded in the headend 11. Headend may record content received from outside (satellite television signal). When [the] viewer wish[es] to order [the] program, [the] program reproduces from [the] headend to [the] terminal through [an] optical node” (Advisory Action at pages 2-3). This is not correct.

Headend 11 receives television signals and converts the signals into a format for transmitting them over system 10 (col. 4, lines 5-7). The Examiner has not cited any passage of *Jerding* to support the assertion that headend 11 records a program and reproduces the program. Appellant finds no teaching or suggestion in *Jerding* that headend 11 records a program or reproduces the program; and submits that no element in *Jerding* constitutes the claimed “content recording means for recording content received from the outside.”

In the Advisory Action, the Examiner appears to assert that the content does not have to be recorded at the user end (Advisory Action at page 3). However, claim 1 recites “content recording means for recording content received from the outside.” Therefore, the content to be recorded comes from the outside, such as a server, and is recorded. Even if the content does not have to be recorded at the user end, as asserted by the Examiner, the content must be “received from the outside” before it is recorded.

Jerding does not teach or suggest receiving the content from the outside and recording the received content. Therefore, *Jerding* does not teach a content recording/reproducing apparatus including a “content recording means for recording content received from the outside,” as recited in claim 1. Moreover, *Jerding* does not

teach a content recording/reproducing apparatus including a “content reproduction means for reproducing said recorded content” and a “reproduction control means for controlling a reproducing operation of said content reproduction means in accordance with said viewable period of said recorded content,” as further recited in claim 1.

Jerding fails to teach the claimed subject matter, including at least these elements. Accordingly, *Jerding* cannot anticipate claim 1. Thus, claim 1 is allowable for at least these reasons. Claims 2-12 are also allowable at least due to their depending from claim 1.

Independent claims 13, 25, and 26, while of different scope, recite limitations similar to those of claim 1 and are thus allowable over *Jerding* for at least the same reasons discussed above in regard to claim 1. Claims 14-24 are also allowable at least due to their dependence from claim 13. Therefore, Appellant respectfully requests that the Board reverse the rejection of claims 1-26 under 35 U.S.C. § 102(e).

CONCLUSION

For at least the reasons given above, pending claims 1-26 are allowable over *Jerding*. Therefore, Appellant respectfully requests the Board to reverse the Examiner's rejection of claims 1-26 under 35 U.S.C. § 102(e).

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 4, 2007

By: 

Michael R. Kelly
Reg. No. 33,921

VIII. Claims Appendix to Appeal Brief Under Rule 41.37(c)(1)(viii)

1. A content recording/reproducing apparatus for controlling the recording and reproducing of content limited in viewable period, comprising:

content recording means for recording content received from the outside;

determination means for determining a viewable period of the recorded content;

presentation means for presenting information associated with said viewable period of said recorded content;

content reproduction means for reproducing said recorded content; and

reproduction control means for controlling a reproducing operation of said content reproduction means in accordance with said viewable period of said recorded content.

2. The content recording/reproducing apparatus according to claim 1, wherein said determination means determines said viewable period of content on the basis of a recording retention period unique to each content.

3. The content recording/reproducing apparatus according to claim 2, wherein said determination means determines said viewable period of content on the basis of a period of time from at least one of a point of time at which the distribution of said content is started and a point of time at which at least one of the reception and recording of said content is started by said content recording means to a point of time at which said recording retention period given to said content passes.

4. The content recording/reproducing apparatus according to claim 2, wherein said determination means determines said viewable period of content on the basis of a period of time from a point of time at which the reproduction of said content is first started by said content reproduction means to a point of time at which said recording retention period given to said content passes.

5. The content recording/reproducing apparatus according to claim 1, wherein said presentation means presents said information associated with said viewable period of said recorded content by superimposing said information on a reproduction signal of said content generated by said content reproduction means.

6. The content recording/reproducing apparatus according to claim 1, wherein said presentation means presents said information associated with said viewable period of said recorded content through an output device different from a reproduction output device of said content.

7. The content recording/reproducing apparatus according to claim 1, wherein said presentation means transmits said information associated with said viewable period of said recorded content to a predetermined communication path.

8. The content recording/reproducing apparatus according to claim 1, wherein said reproduction control means prohibits the reproduction of the content of which viewable period has passed, by said content reproduction means.

9. The content recording/reproducing apparatus according to claim 1, further comprising:

control input means for accepting user command input;

wherein, in response to an instruction for moving a content viewing start position through said control input means, said reproduction control means instructs said content reproduction means to move a content viewing position and said presentation means presents information associated with the viewable period of the reproduced content.

10. The content recording/reproducing apparatus according to claim 1, further comprising:

control input means for accepting user command input;

wherein, in response to an instruction for clearing a viewing pause operation through said control input means, said presentation means presents said information associated with said viewable period of said content, and if said viewable period of said content has not been passed, said reproduction control means instructs said content reproduction means to start reproducing said content.

11. The content recording/reproducing apparatus according to claim 1, wherein, in response to the expiration of said viewable period of content in a viewing paused

state, said reproduction control means starts reproducing said content in the viewing paused state regardless of a user instruction for clearing said viewing paused state.

12. The content recording/reproducing apparatus according to claim 1, wherein, in response to the expiration of said viewable period of content in a viewing paused state, said reproduction control means starts reproducing said content in the viewing paused state regardless of a user instruction for clearing said viewing paused state and said presentation means presents an elapsed time from the start of the reproduction of said content and/or information indicative of the expiration of said viewable period.

13. A content recording/reproducing method for controlling the recording and reproduction of content limited in viewable period, comprising the steps of:

recording content received from the outside;
determining a viewable period of the recorded content;
presenting information associated with said viewable period of said recorded content; and
reproducing said recorded content in accordance with a relationship between a recording retention period of said recorded content and a current time.

14. The content recording/reproducing method according to claim 13, wherein, in said determination step, said viewable period of content is determined on the basis of a recording retention period unique to each content.

15. The content recording/reproducing method according to claim 14, wherein, in said determination step, said viewable period of content is determined on the basis of a period of time from at least one of a point of time at which the distribution of said content is started and a point of time at which at least one of the reception and recording of said content is started in said content recording step to a point of time at which said recording retention period given to said content passes.

16. The content recording/reproducing method according to claim 14, wherein, in said determination step, said viewable period of content is determined on the basis of a period of time from a point of time at which the reproduction of said content is first started in said content reproduction step to a point of time at which said recording retention period given to said content passes.

17. The content recording/reproducing method according to claim 13, wherein, in said presentation step, said information associated with said viewable period of said recorded content is presented by superimposing said information on a reproduction signal of said content.

18. The content recording/reproducing method according to claim 13, wherein, in said presentation step, said information associated with said viewable period of said recorded content is presented through an output device different from a reproduction output device of said content.

19. The content recording/reproducing method according to claim 13, wherein, in said presentation step, said information associated with said viewable period of said recorded content is transmitted to a predetermined communication path.

20. The content recording/reproducing method according to claim 13, wherein, in said reproduction control step, the reproduction of the content of which viewable period has passed is prohibited.

21. The content recording/reproducing method according to claim 13, wherein, in response to an instruction for moving a content viewing start position from a user, a content viewing position is moved in said content reproduction step, and information associated with the viewable period of the reproduced content is presented in said presentation step.

22. The content recording/reproducing method according to claim 13, wherein, in response to an instruction for clearing a viewing pause operation from a user, said information associated with said viewable period of said content is presented in said presentation step, and if said viewable period of said content has not been passed, said content is reproduced in said content reproduction step.

23. The content recording/reproducing method according to claim 13, wherein, in response to the expiration of said viewable period of content in a viewing paused state,

the reproduction of said content in the viewing paused state is started in said content reproduction step regardless of a user instruction for clearing said viewing paused state.

24. The content recording/reproducing method according to claim 13, wherein, in response to the expiration of said viewable period of content in a viewing paused state, the reproduction of said content in the viewing paused state is started in said content reproduction step regardless of a user instruction for clearing said viewing paused state and

an elapsed time from the start of the reproduction of said content and/or information indicative of the expiration of said viewable period is presented in said presentation step.

25. A storage medium physically storing computer software in a computer-readable format, said computer software being written so as to execute, on a computer system, control of recording and reproducing operations of content limited in viewable period, said computer software comprising the steps of:

recording content received from the outside;
determining a viewable period of the recorded content;
presenting information associated with said viewable period of said recorded content; and

reproducing said recorded content in accordance with a relationship between a recording retention period of said recorded content and a current time.

26. A computer readable medium storing a computer program written so as to execute, on a computer system, control of recording and reproducing operations of content limited in viewable period, said computer program comprising the steps of:

recording content received from the outside;

determining a viewable period of the recorded content;

presenting information associated with said viewable period of said recorded content; and

reproducing said recorded content in accordance with a relationship between a recording retention period of said recorded content and a current time.

IX. Evidence Appendix to Appeal Brief Under Rule 41.37(c)(1)(ix)

None.

X. Related Proceedings Appendix to Appeal Brief Under Rule 41.37(c)(1)(x)

None.